

### **REMARKS**

Claims 1-2, 5, 6, 13-14, 17, 21-25, 27, 30-32, 34, 35 and 49-51 are pending. Claims 3-4, 7-12, 15-16, 18-20, and 48 stand withdrawn. Claim 1 has been amended. Support for these claims can be found throughout the specification, including the claims as originally filed. Applicants note that upon allowance of a generic claim, e.g., claim 1, they are be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of any allowed generic claims.

Amendment of the originally filed claims, or cancellation of any claims should in no way be construed as an acquiescence, narrowing, or surrender of any subject matter. The amendments are being made not only to point out with particularity and to claim the present invention, but also to expedite prosecution of the present application. Applicants reserve the option to prosecute the originally filed claims further, or similar ones, in the instant or subsequently filed patent applications.

#### **Priority**

The Action asserts that the “disclosure of the prior-filed application, Application No. 60/431406, fails to provide adequate support or enablement in the manner provided by the first paragraph of 35 U.S.C. 112 for one or more claims of this application.” Applicants respectfully disagree. For example, 60/431406 provides for specific claimed moieties  $R_2$  of claim 1, e.g. the first, second, third, fourth and sixth moiety listed in claim 1. Applicants maintain that the disclosure of 60/431406, filed December 6, 2002 fully supports instant claims, for example, claim 1.

#### **Rejection under 35 U.S.C. § 102(e)**

Claims 1-2, 5, 6, 13-14, 17, 21-25, 27, 30-32, 34, 35, and 49-51 stand rejected under 35 U.S.C. 102(e) as being anticipated by Berman et al. (US2006/0142265). Applicants submit, as noted above, the compounds of claim 1, with e.g., moieties of  $R_2$ , as recited above, have a priority date of December 6, 2002, which is before the first filing date (March 17, 2003) of

US20060142265, and therefore this application does not qualify as prior art under 35 U.S.C. § 102(e).

Further, the priority document of US2006/0142265, application 60/455,189 filed March 17, 2003 does not specifically disclose the elected species or a R<sub>2</sub> moiety such as pyrido[2,3-e]-1,4-diazepine 2-one, and therefore can not form the basis of prior art under 35 U.S.C. § 102(e) for the instant claims, based on the instant application priority filing date of December 6, 2002 or April 25, 2003. Applicants therefore respectfully request withdrawal of this rejection.

#### Double Patenting

Claim 1 stands rejected on the ground of non-statutory obviousness type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,765,005.

As the Examiner knows, determining a basis of a non-statutory double patenting rejection requires a determination of whether any claim in the application defines an invention that is merely an obvious variant of an invention disclosed in a patent or patent application. When considering whether the invention defined in a claim is an obvious variation of the invention defined in the claim of the other patent or patent application, the disclosure in the other patent application may not be used as prior art.

Claim 1 of US 6,766, 005 claims benzo[1,4]diazepin 3-one compounds. Solely in order to expedite prosecution, Applications have amended instant claim 1. Instant claim 1 is generally directed at least in part to compounds where R<sub>2</sub> is a pyrido diazepine 2-one moieties. Applicants believe that the specified claims do not “contain overlapping subject matter,” and it would not be obvious for one of skill in the art to arrive at the compounds of instant claim 1 by starting with the claims of US 6,766,005. Therefore, Applicants respectfully request withdrawal of this rejection.

Any questions raised by this submission may be directed to the undersigned at (617) 570-8743. In accordance with 37 C.F.R. § 1.136(a), please grant any extension of time that this paper requires but no accompanying paper requests. The Commissioner is hereby authorized to charge

any underpayments, or credit any overpayments, to our Deposit Account No. 07-1700,

**Reference: IPT-075.**

**CONCLUSION**

The Examiner is invited to contact the undersigned with any questions about this paper.  
Early favorable action is respectfully solicited.

Respectfully submitted,

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